

buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.”

The Examiner attempts to overcome the deficiencies of Lagoni by combining Lagoni with Goldwasser. The Examiner states that “Goldwasser discloses variable-delay recorder which teaches the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program (col. 2, lines 65-68, col. 3, lines 1-5).”

Applicant respectfully traverse the statements relating to Goldwasser et al. because Goldwasser does not teach or suggest (i) “a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program” as recited in claim 1; (ii) “means for buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program” as recited in claim 12; (iii) “buffering the real-time program from the acceptance of the call” as recited in claim 20; and (iv) “in the event said detecting means detects an incoming phone call, said recording means being capable of recording the video input signal during the phone call, and said displaying means being capable of displaying the recorded video input signal to a user upon termination of the phone call” as recited in claim 22.

There is no teaching or suggestion anywhere in Goldwasser that the variable-delay video recorder is operationally related to a phone, phone call and/or phone system. The system in Goldwasser is entirely user-operated. Each description in Goldwasser that relates to phones or phone calls is done to provide an example reason as to why a user may activate the variable-delay video recorder. Therefore, claims 1, 12, 20 and 22 are believed to be in condition for allowance.

Claims 2-3, 13, 21 and 27-30 depend from respective claims 1, 12, 20 and 22 such that claims 2-3, 13, 21 and 27-30 incorporate all of the limitations of claims 1, 12, 20 and 22. Therefore, claims 2-3, 13, 21 and 27-30 are believed to be in condition for allowance for the reasons provided above with regard to claims 1, 12, 20 and 22 (as well as other reasons).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

According to the Office Action:

"[i]t would have been obvious to one of ordinary skill in the art at the time invention was made to modify Lagoni's system to provide for the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Goldwasser, thus providing enhancements to the Lagoni's system." Pages 3-4, Office Action.

Applicant traverses the assertion as it fails to explain how Lagoni would be modified. It is respectfully submitted that the assertion amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03, and if the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested.

In addition, Applicant respectfully submits that the Examiner's statement regarding a motivation to combine Lagoni and Goldwasser is conclusory because the Examiner's statements are analogous to those made by the Examiner and Board in the recently decided case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

"With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that 'the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software' and that 'another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial' do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use '[use] that which the inventor

taught against its teacher.' *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)." *Lee*, at 1343, 1344.

Reconsideration and allowance of claims 1-3, 12, 13, 20, 21, 22, 27-30 are respectfully requested.

Lagoni, Goldwasser and Natori et al.

Claims 4, 6-9, 14, 16-19 were rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP 02001028645A). Combining Natori with Lagoni and Goldwasser still does not teach or suggest (i) "a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" as recited in claim 1; or (ii) "means for buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" as recited in claim 12.

Claims 4, 6-9, 14, 16-19 depend from respective claims 1 and 12 such that claims 4, 6-9, 14, 16-19 incorporate all of the limitations of claims 1 and 12. Therefore, claims 4, 6-9, 14, 16-19 are believed to be in condition for allowance for the reasons provided above with regard to claims 1 and 12 (as well as other reasons).

The Examiner's only statements relating to a motivation to combine Natori with Lagoni and Goldwasser are at page 5 of the Office Action:

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for storing length of call as this arrangement would provide call history for the user for referencing it when required as taught by Natori.

Applicant traverses the assertion as it fails to explain how Lagoni would be modified. It is respectfully submitted that the assertion amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03, and if the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested. Furthermore, Applicant respectfully submits that the Examiner's statement regarding motivation is conclusory because

the Examiner's statements are analogous to those made by the Examiner and Board in the recently decided case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Reconsideration and allowance of claims 4, 6-9, 14, 16-19 are respectfully requested.

Lagoni, Goldwasser and Tsutsumi

Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Goldwasser as applied to claim 1 above, and further in view of Tsutsumi (JP 406319173A). Combining Tsutsumi with Lagoni and Goldwasser still does not teach or suggest (i) "a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" as recited in claim 1.

Claim 10 depends from claim 1 such that claim 10 incorporates all of the limitations of claim 1. Therefore, claim 10 is believed to be in ~~condition for~~ allowance for the reasons provided above with regard to claim 1.

The Examiner states at page 6 of the Office Action:

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user as this arrangement would enable the user to answer the call without going to the place of handset by using the remote controller as taught by Tsutsumi.

Applicant respectfully submits that the Examiner's statement regarding motivation to combine is again conclusory (*See In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)). If the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested. There is no teaching or suggestion in Tsutsumi relating to caller identification or buffering programs, and Lagoni and Goldwasser provide no suggestion of using a telephone handset as a remote control.

Reconsideration and allowance of claim 10 are respectfully requested.

Lagoni, Goldwasser and Lund

Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Goldwasser as applied to claim 1 above, and further in view of Lund (US 6,342,270 B1). Combining Lund with Lagoni and Goldwasser still does not teach or suggest (i) "a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" as recited in claim 1.

Claim 11 depends from claim 1 such that claim 11 incorporates all of the limitations of claim 1. Therefore, claim 11 is believed to be in condition for allowance for the reasons provided above with regard to claim 1 (as well as other reasons).

The Examiner's only statements relating to a motivation to combine Lund with Lagoni and Goldwasser overlap pages 6 and 7 of the Office Action:

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user as this would enable the user to answer the telephone call without being distracted by television audio as taught by Lund.

Applicant traverses the assertion as it fails to explain how Lagoni and Goldwasser would be modified by Lund. It is respectfully submitted that the assertion amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03, and if the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested.

Furthermore, Applicant respectfully submits that the Examiner's statement regarding motivation to combine is again conclusory and prohibited by the case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). There is no teaching or suggestion in Lund relating to buffering programs, and Goldwasser provides no teaching suggestion as to operationally integrating caller ID into a system of electronic devices.

Reconsideration and allowance of claim 11 are respectfully requested.

Lagoni, Goldwasser, Shimada et al. and Tamura et al.

Claims 25-26 were rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Goldwasser as applied to claim 22 above, and further in view of Shimada et al. (JP 403178247A), and Tamura et al. (JP 404112374A. Combining Shimada and Tamura with Lagoni and Goldwasser still does not teach or suggest “in the event said detecting means detects an incoming phone call, said recording means being capable of recording the video input signal during the phone call, and said displaying means being capable of displaying the recorded video input signal to a user upon termination of the phone call” as recited in claim 22.

Claims 25 and 26 depend from claim 22 such that claims 25 and 26 incorporate all of the limitations of claim 22. Therefore, claims 25 and 26 are believed to be in condition for allowance for the reasons provided above with regard to claim 22 (as well as other reasons).

The Examiner states at pages 7 and 8 of the Office Action:

Thus, it would have been obvious to one of skill in the art at the time invention was made to modify the combination to provide for the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call as this arrangement would facilitate to record messages when user is unable to answer the call as taught by Shimada; voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means as this arrangement would facilitate storage facilities for messages at different locations to suite users requirements when the user is unable to answer the call as taught by Shimada and Tamura.

Applicant traverses the assertion as it fails to explain how Lagoni and Goldwasser would be modified by either Shimada or Tamura much less the combination of Shimada and Tamura. It is respectfully submitted that the assertion amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03, and if the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested.

Furthermore, Applicant respectfully submits that the Examiner's statement regarding motivation to combine is conclusory and prohibited by the case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). There is no teaching or suggestion in Shimada and/or Tamura relating to either buffering programs or incorporating caller ID.

Reconsideration and allowance of claims 25 and 26 are respectfully requested.

Lagoni, Goldwasser and Schultheiss et al.

Claim 23 is rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Goldwasser as applied to claim 22 above, and further in view of Schultheiss et al. (WO 99/35831). Combining Schultheiss et al. with Lagoni and Goldwasser still does not teach or suggest "in the event said detecting means detects an incoming phone call, said recording means being capable of recording the video input signal during the phone call, and said displaying means being capable of displaying the recorded video input signal to a user upon termination of the phone call" as recited in claim 22.

Claim 23 depends from claim 22 such that claim 23 incorporates all of the limitations of claim 22. Therefore, claim 23 is believed to be in condition for allowance for the reasons provided above with regard to claim 22 (as well as other reasons).

The Examiner's only statements relating to a motivation to combine Schultheiss with Lagoni and Goldwasser are at page 8 of the Office Action:

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: recording means comprises a structure selected from the group consisting of: set top box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television as this arrangement would provide varied structure to control and record information as taught by Schultheiss, thus enhancing the usefulness of the system.

Applicant respectfully submits that the Examiner's statement regarding motivation to combine is again conclusory (*See In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)). If the Examiner is aware of a patent providing support for the assertion, citation of the patent is respectfully requested. There is no teaching or suggestion in Schultheiss relating to caller identification or buffering programs.

Reconsideration and allowance of claim 23 are respectfully requested.

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6972) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 12th day of August, 2002. (Monday)

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